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10/665,106	09/17/2003	Peter C. McEachen	LTTK.P6540US	6146

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EXAMINER

MILLER, BENA B

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,106

Applicant(s)

MCEACHEN ET AL.

Examiner

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is lack of proper antecedent basis for the claimed subject matter "the outputs correspond to subtraction of these numerals".

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wigs must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 26 is objected to because of the following informalities: The word -- simulated -- should be inserted before the word "fish". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-4, parenthesis does not further limit the claims in US practices.

Regarding claim 6, it is not clear if whether there is only one or at least one reader since claim 1 recites the phrase "the host structure comprises at least one reader".

In several instances, the claim recites a broad range or limitation followed by linking terms (e.g. preferably, maybe, can be, for instance, especially) and a narrow range or limitation within the broad range or limitation is considered indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Regarding claim 7, it is not clear if whether there is only one or a plurality of reader since claim 1 recites the phrase "the host structure has a plurality of readers".

Regarding claim 8, it is not clear whether the output device is the same as the output device in claim 1.

There is lack of antecedent for the claimed subject "at least some of different outputs".

Regarding claim 28, it is not clear as to what are all of the accessories encompassed in the phrase "other accessories".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by DeSmet et al.

Regarding claim 1, DeSmet teaches in figures 1-9 a toy comprising a host structure (19), a plurality of attachable items (P) that can be selectively attached to the host structure, and an output device (AP), wherein the host structure comprises at least one reader (19T), wherein the plurality of attachable items each include a tag (BC—fig. 1) which, when read by the reader, provides identification information particular to that tag; wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, and wherein the output device generates different outputs depending upon which attachable item has been identified by the reader (col. 4, lines 17-55).

Regarding claim 4, DeSmet further teaches a bar code identification device (fig.1).

Regarding claim 5, DeSmet further teaches the tag comprises a bar printed on the attachable item (col. 6, par. 5-7).

Regarding claim 6, DeSmet further teaches the host structure has only one ready and wherein only one of the attachable items is attachable to the host structure at a time (fig. 6; col. 5, par. 6 and 7).

Regarding claim 10, DeSmet further teaches an audio output (col. 5, par. 2).

Regarding claim 13, DeSmet further teaches at least some of the different outputs occur on at least one of the attachable items (col. 5, par. 3 and 4).

Claims 1-3, 6-8, 11, 21-22 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Galyean III et al.

Regarding claim 1, Galyean III teaches in figures 1-10 a toy comprising a host structure (300,302), a plurality of attachable items (306, 308, 304) that can be selectively attached to the host structure, and an output device (100), wherein the host structure comprises at least one reader (632, 634, 636, 638, 642), wherein the plurality of attachable items each include a tag (see marked copy fig.3)) which, when read by the reader, provides identification information particular to that tag; wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, and wherein the output device generates different outputs depending upon which attachable item has been identified by the reader (col. 5, par. 1).

Regarding claim 2, Galyean III further teaches radio frequency identification device (co. 4, lines 6-8).

Regarding claim 3, Galyean III further teaches radio frequency activation signal, which is received by one of the tags at the time that the corresponding attachable item

is attached, and wherein the tag is powered by the activation signal to transmit identification information to the reader (col. 4, lines 6-8 and col. 4, par. 3).

Regarding claims 6 and 7, Galyean III further teaches the host has only one reader, a plurality and wherein only one and a plurality of the attachable items is attachable to the host structure at a time (col. 4, par. 3 and fig.3).

Regarding claim 8, Galyean III further teaches an output device generates a particular output (col. 5, par. 1).

Regarding claims 20 and 21, Galyean III further teaches the host structure resembles a torso and the attachable items resemble body parts and the identification device generates an output when all the attachable items are attached (fig.3; col. 5, par. 1).

Regarding claim 31, Galyean III teaches in figures 1-10 a toy comprising: a host structure that resembles a torso (300, 302), a plurality of radio frequency readers housed by the host structure at different attachment locations corresponding to missing body parts (co. 4, par. 3 and lines 7-9); a plurality of attachable items, which resemble the missing body parts and which can be selectively attached to the host structure at the different attachment locations (306, 308, 304), a plurality of radio frequency tags, each housed by one of the plurality of attachable items and, when respectively read by one of the readers, providing identification information particular to that attachment item (col. 5, par. 1); wherein each of the readers read the identification information from a particular tag at the time that the corresponding attachable item is attached to the adjacent

attachment location (col. 5, par. 1), and wherein different outputs are generated depending upon which attachable item is identified by the reader.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al.

Regarding claim 1, Lee et al teaches in figures 1-10 a toy comprising a host structure (23), a plurality of attachable items (30) that can be selectively attached to the host structure, and an output device (col. 9, par. 4), wherein the host structure comprises at least one reader (14-17), wherein the plurality of attachable items each include a tag (45) which, when read by the reader, provides identification information particular to that tag; wherein the reader reads the identification information from a particular tag when the corresponding attachable item is attached to the host structure, and wherein the output device generates different outputs depending upon which attachable item has been identified by the reader (col. 9, par. 2).

Regarding claim 9, Lee further teaches a mode selector to select different modes of operation and wherein the outputs change depending upon selected mode of operation (col. 5, par. 2-col. 6, par. 2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSmet.

Regarding the claims, DeSmet teaches in the figures most of the elements of the claimed invention except for the attachable items are different colors, different numerals, and outputs correspond to addition and subtraction of the numerals. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the attachable items to be different color, different numerals and the different outputs correspond to the different colors, numerals and the addition and subtraction of the numerals, since it was known in the art that educational devices have prerecorded or pre-programmed sounds to correspond to a particular element.

Claims 12, 23-25 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galyean, III et al.

Galyean teaches in the figures most of the elements of the claimed invention except for the visual output occurs on the attachable item, the connector comprise a magnetic connecting arrangement and a hook-and-loop fastening arrangement and the attachment items are fitted around. Regarding claim 12, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the visual output to occur on the attachable item, since it was known in the art that visual output on attachable educational devices to provide excitement to an individual.

Regarding claims 23 and 24, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have magnetic connecting and

hook-and-loop fastening , since it was known in the art arrangements such as the magnetic connecting and hook and fastening are used to attach elements together.

Regarding claim 25, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the attachment elements fitted around the host structure, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Regarding claim 32, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the host structure resemble a teddy-bear torso and teddy bear body parts, since it was known in the art that teddy bears are used as an toy or educational device with an output.

#### ***Allowable Subject Matter***

Claims 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

#### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wood teaches a speech synthesizing indicia. White teaches a data communication apparatus. Shackelford teaches smart blocks.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bena Miller  
Examiner  
Art Unit 3712

bbm  
February 09, 2004